

### REMARKS/ARGUMENTS

Claims 1, 3, 13 and 15 have been amended to correct informalities and overcome the Examiner's objections.

Claims 4 and 16 have been amended by deleting tape as an attaching means to overcome the Examiner's obviousness rejection.

#### Examiner's Rejection of Claims 1, 2, 13 and 14 under 35 U.S.C. 102(b)

Regarding claims 1 and 13, Applicant cannot find, in Chien, a flexible electroluminescent wire. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." See In re Dillon, 919 F.2d 688, 16 USPQ2d 1827, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Chien document discloses an electro-luminescent light strip that is neither flexible nor a wire. The flexible electroluminescent wire claimed by the Applicant is flexible and can conform to various shapes, such as around corners, along seams, and into a multitude of designs, such as those shown in Applicant's drawing figures 1, 4 and 4A. Chien fails to disclose and lacks the property and advantage of flexibility asserted in Applicant's claims. The omission in Chien of disclosing a flexible property of its electro-luminescent light strip prevents Chien from being used as a prior art rejection under 35 U.S.C. 102(b). "Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claims." Lindemann Maschinefabrik GmbH v. American Hoist & Derrick Co., 730

F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984), (citing Connell v. Sear, Roebuck & Co., 722

F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983 (emphasis added)).

Chien also fails to disclose a wire. The light strip, or light panel, disclosed in Chien lacks the versatility, flexibility, and durability of the electroluminescent wire as claimed by Applicant. The disadvantages of Chien's electro-luminescent light strip sought to be overcome in Applicant's claims include the non-flexibility of Chien's light strip; that Chien's light strip is more fragile and would not withstand multiple flexing and bending; and that Chien's light strip is limited to flat areas of any articles it is placed on. Contrast Applicant's claimed flexible electroluminescent wire's flexibility, its durability and ability to withstand multiple flexing and bending, and its versatility in being able to be applied and attached to any area of an item, including perimeter seams, in any design imaginable. Chien does not show the identical invention in as complete detail as is contained in Applicant's claims. See, Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); ("The identical invention must be shown in as complete detail as is contained in the ... claim." Id. at 1236, 9 USPQ2d at 1920).

Regarding claims 2 and 14, Chien discloses a circuit means that has a function interface for an electro-luminescent light strip, whereas Applicant claims a circuit means with a function interface for a flexible luminescent wire that includes means to switch the flexible luminescent wire on and off intermittently in a random or predetermined pattern.

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single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner reference Chien column 4, lines 61-67, however that citation refers to claims in Chien for a dry cell battery, a manual pushbutton switch, and an adjustable strap. Chien discloses a steady, flash, sequential or random light strip, whereas Applicant claims a function interface means for a flexible luminescent wire to turn on and off intermittently in a random or a predetermined pattern. Each element found in claims 2 and 14, which depend upon claims 1 and 13, is not found in Chien.

Examiner's Rejection of Claims 3-10 and 15-22 under 35 U.S.C. 103(a)

Regarding claims 3-10 and 15-22 being rejected under 35 U.S.C. 103(a) as being unpatentable over Chien in view of Bryan, Applicant restates and relies upon the arguments and remarks set forth above that Chien is not a proper prior art reference. Further, the record does not appear to establish the requisite motivation for combining Chien and Bryan. Applicant argues that the independent claims 1 and 13 are non-obvious, thus all claims dependent upon those independent claims should also be non-obvious.

In analyzing the obviousness of the subject matter at issue, what must first be determined is "analogous prior art". "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with

which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Chien discloses a light strip. Applicant discloses a flexible luminescent wire. Bryan discloses an accessory system for containers and the like to illuminate the inside of those containers to enable to user to see inside the container. Applicant's invention illuminates the outside of wearable items for decorative and safety purposes. It appears that Chien and Bryan are not analogous prior art and should not be used as a basis for an obviousness rejection.

An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. See Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Miles Labs., Inc. v. Shandon Inc., 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The record does not appear to establish the requisite motivation for combining Chien and Bryan.

Regarding claims 3 and 15, the proposed combination does not teach or suggest all of the elements. Bryan discloses a “timer mechanism . . . for causing illumination . . . for a predetermined period of time upon the closing of a switch” (column 9, lines 38-40). This disclosure clearly states that the mechanism described in Bryan requires the activation (closing) of a switch which turns on the illumination for a period of time. In contrast, Applicant claims a time out switch that requires no additional activation, wherein the current is simply terminated after a set period of time. By comparison, Bryan discloses an illumination feature that is mostly “off” until activated by a switch turning the light “on” and activating the “times out” feature after a certain period of time. Applicant, however, claims an illumination feature that is mostly “on” and that no further activation is required for the timer to work. The function of the timer disclosed in Bryan is different than the function of the timer claimed by the Applicant.

Regarding claims 4 and 16, Applicant has amended those claims to delete tape as an attaching means.

Regarding claims 5 and 17, Chien discloses a DC/AC converter for a light strip, whereas Applicant claims a DC power supply and means for converting it to an AC current, thus supplying the flexible luminescent wire with AC current. An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. See Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Miles Labs., Inc. v. Shandon Inc., 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). The Examiner has not rejected claims 1 or 13 under the obviousness rejection set

forth in 35 U.S.C. 103(a). Applicant also argues that all claims dependent upon non-obvious claims 1 and 13, therefore, should not be rejected as obvious. Chien is not analogous prior art, as set forth above, and Chien's disclosure varies greatly from Applicant's claims, thus Applicant argues that the obviousness rejection of claims 5 and 17 should be removed.

Regarding claims 6 and 18, Applicant relies upon the same arguments and comments as set forth above in regards to claims 3 and 15, and claims 5 and 17.

Regarding claims 7 and 19, Applicant relies upon the same arguments and comments as set forth above in regards to claims 3 and 15, and claims 5 and 17. Additionally, Bryan is not analogous prior art, as argued above.

Regarding claims 8 and 20, Applicant relies upon the same arguments and comments as set forth above in regards to claims 3 and 15, and claims 5 and 17. Additionally, Applicant argues that Chien discloses a light strip, which differs significantly from Applicant's claimed flexible luminescent wire and relies upon the arguments above relating to those differences.

Regarding claims 9-10 and 21-22, Applicant relies upon the same arguments and comments as set forth above in regards to claims 3 and 15, and claims 5 and 17.

Examiner's Rejection of Claims 11-12 and 23-24 under 35 U.S.C. 103(a)

Applicant relies upon all of the above arguments and remarks in response to this rejection.

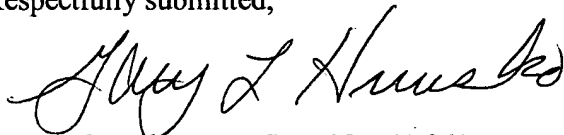
Additionally, Yei discloses an illuminated display panel that differs in many respects from Applicant's claimed flexible luminescent wire. Yei's panel attaches to flat areas of any wearable item. Applicant's flexible luminescent wire can attach anywhere on any surface of any wearable article. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The record does not appear to establish the requisite motivation for combining Chien and Yei. Neither Chien nor Yei disclose a flexible luminescent wire as claimed by Applicant.

#### **Conclusion**

Applicant respectfully requests that the objections and rejections be removed and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Gary L. Huusko, Atty. Reg. No: 41,861  
7300 West 147<sup>TH</sup> Street, Suite 600  
Apple Valley, MN 55124-7580  
(952-432-3136  
huuskog@seversonsheldon.com